

REMARKS

In this response, applicants have amended claims 1-10, 12-13, 16, 18-20, 22, 24-29, 31-32, and 34-39; cancelled claims 11 and 17; and added claim 40. After entry of the current amendments, claims 1-10, 12-16 and 18-40 will be pending.

Interview Summary

Applicants respectfully thank the Examiner for the interview of March 20, 2003. In the interview, the Examiner stated that while claim 32 is not a method claim, claim 32 is a product by process claim that would require an additional search. Applicants also noted that the original specification included claims 1-39, not claims 1-40.

Response to Restriction Requirement

Applicants have added one new claim (claim 40) that is dependent from claim 1 and is therefore properly categorized as a Group I invention as the Examiner has used this designation in the December 17, 2002 restriction requirement.

Applicant hereby elects Group I (claims 1-31 and added claim 40), with traverse.

The Examiner alleges that Group I, claims 1-31, is drawn to a product classified in class 424, subclass 93.1, and Group II, claims 32-40, is drawn to a method of making a product, classified in class 435, subclass 252.1. The Examiner further asserts that “inventions I and II are related as process of making and product made.” The Examiner further argues that the “metabolite of Group I is not required to be isolated in the same way that the metabolite of Group II is required to be isolated in order to formulate the antifungal composition,” and that “the metabolite of Group II may be different from the metabolite of Group I based upon how it is made.”

As an initial matter, the compositions and methods of treating plants using the compositions of Group II are misclassified. Claim 32 is drawn to a composition made by a

process, and claim 32 is not directed to a method, as the Examiner has stated. The composition thus should be classified in the same class and subclass as the product claims of Group I.

In addition to being in the same category as product claims, the product-by process claims of Group II have the same standard of patentability as those of Group I. Claim 1 is directed to a product, and claim 32 is directed to a product made by a process. Product-by-process claims “are not limited to the manipulation of the recited steps, only the structure implied by the steps.” MPEP 2113. Further, “the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” MPEP 2113.

Since the claims of Group I and claims of Group II should be classified in the same class and subclass, and the claims of Group I and Group II must satisfy the same standard of patentability, Applicants respectfully request that the Examiner withdraw the restriction requirement.

Applicant expressly reserves his/her right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

Applicant requests the Examiner withdraw the restriction requirement and examine all pending claims. If the Examiner maintains the restriction requirement, applicants request that the claims of Group I (i.e., claims 1-31 & 40) be examined.

CONCLUSION


Applicants have, by way of the amendments and remarks presented herein addressed all issues that were raised in the outstanding Office Action. Applicant respectfully contends that this Amendment has overcome the rejections and that the pending claims are in condition for allowance. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 311412001820. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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By: _____


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